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EXAMINER

AL HASHEMI, SANA A

ART UNIT

PAPER NUMBER

2164

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/824,117

Applicant(s)

BOYD ET AL.

Examiner

Sana Al-Hashemi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 33-45 and 53-63 is/are pending in the application.
- 4a) Of the above claim(s) 1-32, and 46-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-45, and 53-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is issued in response to applicant's amendment filed 8/26/05.
2. Claims 33-45, and 53-63 are pending. Claims 1-32, and 46-52 are withdrawn.
3. Applicant's arguments filed 8/26/05 have been fully considered but they are not persuasive.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-45, and 53-63 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding Claims 33-45 the claimed subject matter in "using camera to capture at least one image, and using said camera to capture information associated with said image, wherein

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said information is stored in a database". No support found in the specification for this amendment.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 33-39, 40-45, 53-55, and 60-63, are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al. (Slater hereinafter) (US Patent 6,483,570) in view of Parulski et al (Parulski hereinafter) (US Patent No. 6,629,104).

Regarding Claims 33, 59, Slater discloses a method comprising:

using camera to capture at least one image; (see Col 5, lines 52-55, Slater), Slater is silent regarding the use of a digital camera, although, no images can be captured or processed without the use of a camera and to expedite the prosecution the Examiner presents a secondary reference Parulski discloses the use of a camera to capture images (Fig. 2, 10, Col. 3, lines 39-45). It would have been obvious to use the camera to capture photos since it's the only way images can be captured.

capture information associated with said image, wherein said information is stored in a database; and (see Col. 2, lines 55-63, Parulski); and

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using said information to generate a label having an identifier, wherein the label is adapted to be affixed to a storage device that is adapted to hold printed copies of the plurality of images (see column 6, lines 1-8, Slater, Col. 3, lines 14-26, Parulski).

Regarding Claim 34, Slater in view of Parulski discloses a method wherein said image is a digital image further comprising:

storing each image of the plurality of images in said database (see column 7, lines 30-37, Slater);

Regarding Claims 35, and 44, Slater in view of Parulski discloses a method wherein capturing said information comprises:

forming metadata during formation of said image(see column 7, lines 51-54, Slater).

Regarding Claim 36, Slater in view of Parulski discloses a method wherein capturing said information comprises:

accepting said information from a user (see column10, lines 19-27, Slater).

Regarding Claims 37, and 43, Slater in view of Parulski discloses a method wherein the information is at least one of:

GPS coordinates;

a time;

a date;

camera information;

an audio file;

at least one keyword;

a description of subject matter of the image (see column 15, lines 1-6, Slater); and

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an event associated with the image (see column 6, lines 1-10, Slater).

Regarding Claims 38, Slater in view of Parulski discloses a method wherein the storage device is selected from the group consisting of:

an envelope (see column 7, lines 60-65, Slater);

an album; and

a box.

Regarding Claim 40, Slater in view of Parulski discloses a method further comprising:

forming at least a portion of the plurality of images by a non-digital camera (see column 10, lines 32-39, Slater); and

converting the at least a portion of the plurality of images into digital form (see column 10, lines 2-10, Slater).

Regarding Claim 41, Slater in view of Parulski discloses a method further comprising:

placing the label on the storage device (see column 7, lines 60-65, Slater); and

placing printed copies of the plurality of images in the storage device (see Fig. 7, Slater).

Regarding Claim 42, Slater in view of Parulski discloses a method further comprising:

searching the database with a query to locate a printed copy of one image of the plurality of images (see column 6, lines 31-43, Slater);

providing the identifier associated with the one image (see column 6, lines 44-47m Slater) ;

locating the storage container with the label having the identifier (see column 6, lines 45-49, Slater);

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searching the storage container for the printed copy of the one image (see column 7, lines 30-35, Slater).

Regarding Claim 45, Slater in view of Parulski discloses a method further comprising:  
searching the database with a query to locate the printed copy of the image (see column 6, lines 31-43, Slater); and

providing the thumbnail representation of the image (see column 10, lines 19-27, Slater).

Regarding Claim 53, Slater in view of Parulski discloses a method comprising:  
generating information identifying an image at a time said image is captured (Col. 2, lines 28-38, Parulski);

automatically producing meta-data associated with said image (Col. 3, lines 9-13, Parulski);

providing the meta-data into a database (Col. 3, lines 5-8, Parulski);

generating a label that is adapted to be affixed to a storage device adapted to hold a printed copy of said image, wherein said label has an identifier generated from said identifying information (see column 6, lines 1-8, Slater, Col. 3, lines 14-26, Parulski); and

providing said identifier into said database (Col. 6, lines 9-21, Parulski).

Regarding Claims 54, Slater in view of Parulski discloses a method wherein said identifying information is automatically generated by a device capturing said image (see column 14, lines 6-8, Slater);.

Regarding Claims 55, Slater in view of Parulski discloses a method further comprising:  
providing a thumbnail representation of the image into the database (see column 11, lines 20-30, Slater); and

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printing the thumbnail representation on the label (see column 11, lines 30-46, Slater).

Regarding Claim 56, Slater in view of Parulski discloses a method wherein the meta-data includes global position system (GPS) coordinates acquired at a time when the image is produced.

Regarding Claim 60, Slater in view of Parulski discloses a method further comprising: generating a thumbnail of said image on said label (see column 11, lines 20-30, Slater).

Regarding Claim 61, Slater in view of Parulski discloses method further comprising: organizing said images on said computer using said meta-data (Col 5, lines 43-54, Parulski).

Regarding Claim 62, Slater in view of Parulski discloses a method further comprising: automatically creating, with said computer, said identifier (col. 6, lines 1-8, Parulski).

Regarding Claim 63, Slater in view of Parulski discloses a method further comprising: storing, in said computer, said meta-data, said user data, and said identifier (col. 6, lines 1-8, Parulski).

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 39, 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al. (US Patent 6,483,570) in view of Parulski et al (Parulski hereinafter) (US Patent No. 6,629,104) and further in view of Reed (US Patent No. 6,426,801).



Regarding Claim 39, the combination of Slater in view of Parulski discloses all of the claimed subject matter as set forth above. However, the combination of Slater in view of Parulski is silent with regard to the method of forming at least a portion of the plurality of images by a digital camera. However, Reed on the other hand discloses the use of formatting at least a portion of the plurality of images by a digital camera (see column 6, lines 26-32, Reed). It would have been obvious to one of ordinary skill in the art to develop films from digital camera as suggested by Reed, with the motivation of increasing the market share and make it accessible for higher verity of customers, which in other words increase the company's revenue.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al. (US Patent 6,483,570) in view of Parulski et al (Parulski hereinafter) (US Patent No. 6,629,104) and further in view of Kinjo (US Patent No. 6,813,395).

Regarding Claim 56, the combination of Slater in view of Parulski discloses all of the claimed subject matter set forth above. However, Slater does not disclose the use of the GPS to coordinates acquired at a time when the image is produced. On the other hand, Kinjo discloses the use of the GPS coordinating at the time the image is produced. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the GPS in coordinating the time of the image is to provide the user with higher and more specific details as taught by Kinjo column 23, lines 1-54.

Regarding Claim 57, Slater in view of Kinjo discloses a method further comprising:

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searching for the image in the database by submitting a query to the database, wherein the query includes criteria associated with at least one of the meta-data and the user data (see column 24, lines 32-42, Kinjo).

Regarding Claim 58, Slater in view of Kinjo discloses a method further comprising:

displaying a thumbnail representation of the image upon matching the query to the image in the database (see column 17, lines 48-57, Slater).

### ***Response to Arguments***

With respect to applicant argument Examiner believes all the argued limitations are not disclosed or defined in the specification on the application.

Applicant argues that the Examiner did not "establish a prima facie case of obviousness; three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill on the art to modify the references or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations". Without conceding that the combination of Slater and Parulski meets any of the other requirements. The applicant points out that such combination fails to teach or suggest all of the claim limitations of applications invention.

Examiner disagrees with the application statement of the "without conceding that the combination of Slater and Parulski meets any of the other requirements."

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Examiner believes that a prima facie case has been established. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill on the art to modify the references or to combine reference teaching.

The Slater reference teaches the method of processing captured images which must be captured by a camera there is no other ways to capture images without the use of camera, so the use of camera in this case is inherent, the Parulski teaching the use of a camera in capturing images which can be processed by the Slater, the combination in this case is obvious to one of ordinary skill in the art at the time the invention was made.

Second, there must be a reasonable expectation of success. Examiner response without the use of camera to capture images as taught by Parulski the Slater system will not work in the first place and that is a reasonable expectation of success.

Finally, the prior art cited must teach or suggest all the claim limitations. Examiner addressed all the limitations claimed as stated in the rejection above.

Applicant argues that the Parulski citation relied on by the Examiner did not teach the claimed limitation of "using said camera to capture information associated with said image".

Examiner disagrees. Since the applicant did not define a specific way to capture the information associated with the image in specification. The Examiner interpreted to correspond to the method of creating a label for the images in order to retrieve the saved images, which is in other words capturing information associated with the images.

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*Points of Contact*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sana Al-Hashemi whose telephone number is 571-272-4013.

The examiner can normally be reached on 8Am-4:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on 571-272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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October 27, 2005